



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,343	11/12/2003	Roger A. Dulin	23638-040	6825

7590 07/10/2006
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY and POPEO, P.C.
One Financial Center
Boston, MA 02111

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,343

Applicant(s)

DULIN ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 04/27/2006 has been fully considered. Claims 15, 18 and 20 are amended, claims 1-14 are canceled, claims 21-26 are added, and claims 15-26 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 15-18 are rejected under 35 U.S.C. 102(a) as being anticipated by Mehta et al. (US 6,123,253).
4. Mehta discloses a business form or mailer comprising a substrate sheet with a first end (equivalent to the claimed top edge), a second end (equivalent to the claimed bottom edge), a first side edge and a second side edge. One or more fold lines traversing a width of the sheet to form one or more panel sections. A line of weakening disposed longitudinally along the first side edge of the sheet to define a first marginal strip between the line of weakening and the first side edge, and a line of weakening disposed longitudinally along the second side edge to define a second marginal strip between the line of weakening and the second side edge. Adhesive patterns are disposed longitudinally along each of the first and second marginal strips; and along the first end of the sheet. (See Figs. 1 and 2, and col. 4, line 48 thru col. 5, line 64). The

Art Unit: 1774

sheet further comprises a feed strip with a plurality of feed holes attached to each of the first and second side edges (Fig. 8 and col. 9, line 53). The business form or mailer further comprises an insert and/ or a return envelope incorporated with the sheet (col. 9, line 2). The sheet also comprises a transparentized viewing area located on a predetermined position of the sheet and formed on an exterior surface of the mailer (col. 7, line 31). The process by which the transparentized viewing area is formed is not dispositive of the issue of the instant article claims.

Response to Arguments

5. Applicant's argument is based on that Mehta does not disclose the limitation of one or more lines of adhesive or cohesive disposed at one or more positions along the top edge of the sheet, wherein the one or more adhesive or cohesive positions are at least one of: (i) located flush with the top edge of the sheet and (ii) located proximate to the top edge of the sheet. This argument is not persuasive because Mehta teaches having adhesive patterns provided **very close** to the first end of the sheet (Fig. 1, and col. 5, lines 57 and 58). Therefore, claims 15-18 stand rejected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. (US 6,123,253), as applied to claims 15-18, above, in further view of Mehta (US 6,103,355).

8. Mehta '253 does not disclose that the sheet contains font images on the transparentized viewing area. Mehta '253 teaches having a return envelope toward the second end (Fig. 6, and col. 8, line 52-65).

9. Mehta '355 teaches a mailer or envelope which has at least one transparentized portion (abstract). The mailer or envelope comprises a substrate having a lower surface and an upper surface, and a reverse image is printed on the lower surface transparentized portion.

10. Mehta '253 and Mehta '355 are analogous art because they are from the same field of endeavor that is the mailer or envelope art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply reverse images on a back surface of the transparentized viewing area of the sheet of Mehta '253 so that the image of reverse image is the image that will be seen by the observer, and applying reverse images on a back surface of a transparentized portion of a substrate is well known in the art (see col. 27, line 25 of Mehta '355).

11. With respect to claims 22 and 23, Mehta '253 discloses the claimed invention except the location of the transparentized viewing area. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the transparentized viewing area between the first end and the one or more fold lines, since

Art Unit: 1774

it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

12. With respect to claim 24, Mehta '253 discloses the claimed invention except for the continuous line of adhesive along the first side edge and second side edge. It would have been obvious matter of design choice to have continuous line of adhesive along the first side edge and second side edge, since applicant has not disclosed that continuous line of adhesive along the first side edge and second side edge solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the adhesive patterns along the first side edge and second side edge

13. With respect to claims 25 and 26, Mehta '253 teaches having a return envelope toward the second end (Fig. 6, and col. 8, line 52-65).

Response to Arguments

14. Applicant's argument is based on that Mehta does not disclose the limitation of one or more lines of adhesive or cohesive disposed at one or more positions along the top edge of the sheet, wherein the one or more adhesive or cohesive positions are at least one of: (i) located flush with the top edge of the sheet and (ii) located proximate to the top edge of the sheet. This argument is not persuasive because Mehta teaches adhesive patterns provided very close to the first end of the sheet (Fig. 1, and col. 5, lines 57 and 58). For the above reason claims 15-20 stand rejected and claims 21-26 are also included in the rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.


18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1774

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.

June 29, 2006.


BETELHEM SHEWARAGED
PRIMARY EXAMINER